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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/413,984	10/07/1999	TOSHIYA KITAMURA	990630/HG	2673

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

DOVE, TRACY MAE

ART UNIT	PAPER NUMBER
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1745

15

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-15

Office Action Summary

Application No.

09/413,984

Applicant(s)

Kitamura

Examiner

Tracy Dove

Art Unit

1745



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 8, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-8, 10-12, and 14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 10-12, and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

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DETAILED ACTION

This Office Action is in response to the communication filed on 4/8/02. Applicant's arguments have been considered, but are not persuasive. Claims 1, 2, 4-8, 10-12 and 14 are rejected in view of the prior art of record. This Action is made Non-Final.

Continued Prosecution Application

The request filed on 4/8/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

Claim Objections

Claims 5 and 11 are objected to as being duplicate claims. Claim 5 is identical to claim 4 and claim 11 is identical to claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-8, 10-12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 2, 6-8 and 12 recite a "conventional alloyed zinc powder", which is indefinite because it is unclear what "conventional" encompasses.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-8, 10-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Glaeser, US 5,240,793.

See Office Action of 3/28/01 for the reasons for rejection.

Claims 1, 2, 7, 8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyasaka, JP 5-151968.

Miyasaka teaches an alkaline battery with less gas generation having a zinc negative electrode including zinc powder and bismuth attached to the surfaces of the zinc powder. See page 1 of translation under "Constitution". The example (page 4) teaches bismuth added to zinc powder wherein the zinc powder is a zinc alloy containing indium and aluminum. The particle

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size of the zinc powder is 100-300 μm . The bismuth is added in an amount of 0.005-0.5 wt% (bottom of page 3).

Thus the claims are anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 102(b)/103(a) as being anticipated by, and alternatively unpatentable over, Miyasaka, JP 5-151968.

See discussion of Miyasaka above.

Miyasaka does not explicitly state the bismuth powder and alloyed zinc powder are dry mixed.

However, the courts have ruled the product-by-process claims, in the absence of unexpected results, are obvious. Miyasaka teaches that the bismuth is added as a solution to the zinc alloy powder. Applicant must provide evidence that the electrode material of the instant claims is substantially different than that of the prior art to overcome the rejection.

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Response to Arguments

Applicant's arguments filed 4/8/02 have been fully considered but they are not persuasive.

Glaeser

Applicant argues the zinc powder of Glaeser is no more than one of the well-known prior art powders discussed in the instant specification (page 2, lines 2-6). However, Glaeser teaches the zinc alloy powder having a metal (Bi) applied into or onto the zinc (not disclosed by instant specification). Glaeser teaches a zinc powder for alkaline batteries and a process for preparing the zinc powder with a very low gas evolution in the alkaline electrolyte by *alloying or applying metal into or onto zinc*. See col. 1, lines 8-11. Note is col. 1, lines 25-28. Glaeser states all conventional zinc powders for alkaline batteries, more specifically if low in or free from mercury, contain considerable amounts of lead. Therefore, the zinc powder (zinc alloyed with at least lead) may have a metal alloyed with, applied into or applied onto the zinc powder. Note the claimed invention does not require the zinc alloy (mixed with the Bi and/or In) to contain Bi and/or In.

Applicant points out Tables 1 and 2 to show evidence of unexpected results for the claimed invention. However, unexpected results are not sufficient to overcome a 35 U.S.C. 102(b) rejection. See MPEP 2131.04:

Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Note the abstract of Glaeser teaches a zinc powder may contain lead, indium, gallium and alkali and/or alkaline earth metals. The powder *additionally* contains 100-1000 ppm of bismuth.

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Thus Applicant's arguments regarding Glaeser are not convincing.


Urry

The rejection in view of Urry is withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached Monday-Thursday (9:00 AM-7:30 PM). My supervisor is Pat Ryan, who can be reached at (703) 308-2383. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax numbers are 703-872-9310 (after non-final) and 703-872-9311 (after final).

May 30, 2002


CAROL CHANEY
PRIMARY EXAMINER